REMARKS/ARGUMENTS

Claims 1, 4-7, 10-11, 13, 16-19, 22-23 and 25-27 remain rejected as being unpatentable over Kondo (U.S. 5,713,021) in view of Kanevsky (U.S. 7,075,671).

Claims 2-3, 8-9, 12, 14-15, 20-21, 24 and 28 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Kondo (U.S. 5,713,021) in view of Kanevsky (U.S. 7,075,671) further in view of Orr (U.S. 6,430,357).

Claim Rejections Under 35 U.S. C. § 103(a)

Applicants respectfully traverse the rejections to claims 1, 4-7, 10-11, 13, 16-19, 22-23 and 25-27 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Kondo, in view of Kanevsky. The Office Action alleges that the combination of references teach or disclose all of the claimed limitations of the corresponding claims and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Kondo with the teachings of Kanevsky.

Applicants, however, respectfully submit that a prima facie case of obviousness has not been established by the evidence presented in the Office Action. In order to establish a prima facie showing of obviousness, three requirements must be satisfied: all limitations of a pending claim must be expressly or impliedly disclosed by prior art references; there must be a suggestion or motivation in the art for the ordinarily skilled artisan to combine the limitations; and there must be a reasonable expectation of success in making such a combination. (M.P.E.P. § 2143).

Applicants respectfully submit that Kondo and Kanevsky, either individually or in combination, fail to teach or suggest at least one of the claim limitations recited in each of claims 1, 4-7, 10-11, 13, 16-19, 22-23 and 25-27.

Claim 1

Claim 1 recites, in part, the features of "receiving input identifying a selection criterion" and "analyzing the multimedia information stored by the plurality of multimedia

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documents in response to the input to identify portions of multimedia information that satisfy the selection criterion." The Office Action alleges that Kondo's search system discloses the above recited features. Applicants respectfully disagree.

The Office Action alleges that the abstract of Kondo teach "a multimedia data search system for storing and searching features of a portion of data." (Office Action: Page 11, first full paragraph after f); emphasis in original). The Office Action further alleges that using the broadest reasonable interpretation of the claims, the skilled artisan would realize a search system that allows the user to search multimedia portions depending on their requirements would qualify as being "input identifying a selection criteria" as recited in claim 1. Applicants respectfully disagree because there is a substantial difference between "searching features of a portion of data" (emphasis added) as asserted by the Office Action and disclosed in Kondo, and "analyzing the multimedia information stored by the plurality of multimedia documents in response to the input to identify portions of multimedia information that satisfy the selection criterion" as recited in claim 1. (Emphasis added).

Kondo teaches that a multimedia data search system includes a storage unit for storing "features of a portion of data and data identifying the portion of data." (Kondo: Abstract). Kondo separates the actual multimedia data from "features" of the multimedia data, e.g., into view objects that have keywords and "pointers" to the actual data. (Kondo: FIG. 2; element 11 - multimedia storage part and element 12 - view object storage part). Thus, the multimedia data search system of Kondo includes a "search unit for searching view objects stored in the storage unit according to a feature of the portion of data." (Kondo: Abstract, emphasis added). Accordingly, Kondo reiterates that the "system implemented with this invention facilitates searching for a portion of sequential data, and displays neighboring data depending on a requirement when displaying the portion of data." (Kondo: Abstract). In other words, Kondo teaches searching "features" or separate view objects that are different from the actual multimedia data according to some requirement, and displaying the "neighboring data" or the actual multimedia data that has been linked to the view object that meets the requirement when the search is performed.

Kondo simply fails to teach or suggest that the portions of multimedia are actually searched by the search unit of Kondo as alleged in the Office Action. (Office Action: Page 11, bottom paragraph). FIG. 12 of Kondo is a flowchart "for searching and displaying multimedia data." (Col. 2, lines 39-40). Kondo discloses that the view object management part 13 searches for a corresponding view object depending on a specified keyword in Step S6. (Kondo: Col. 6, lines 33-36; emphasis added). Kondo further discloses that when the search results are displayed, the user decides whether to continue a search or whether to display the resultant view objects in Step S8. (Kondo: Col. 6, lines 52-54). If the user in Kondo decides to continue the search, the process goes back to S6, else if the user decides to display a portion of data corresponding to the view object, the method "display()" or "play()" is invoked by each of view objects searched by the multimedia data display/reproduction part 14 to represent data in a way corresponding to each of view objects in Step S9. (Kondo: Col. 6, lines 55-60).

In contrast, claim 1 recites that input identifying a selection criterion is received, and multimedia information (stored by a plurality of multimedia documents) is analyzed in response to the input to identify portions of multimedia information that satisfy the selection criterion. Thus, even giving the claim terms their broadest reasonable interpretation, it is clear that the process of analyzing multimedia information stored by a plurality of multimedia documents in response to input to identify portions of multimedia information that satisfy a selection criterion specified by the input as recited in claim 1 is substantially different from Kondo's disclosure of searching one pre-created view object after another to determine whether features or attributes stored in the view object match input provided by a user.

Thus, Applicants submit that Kondo fails to teach or suggest the features of "receiving input identifying a selection criterion" and "analyzing the multimedia information stored by the plurality of multimedia documents in response to the input to identify portions of multimedia information that satisfy the selection criterion" as recited in claim 1.

After incorrectly stating that Kondo discloses that portions of multimedia are searched from multiple types of multimedia information, the Office Action states that "it would be easily possible to extract a first and second portion from different multimedia data."

Applicants note that the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. In re Rijckaert, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); In re Oelrich, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). Thus, Applicants respectfully disagree.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999). Thus, merely because it would be "easily possible" according to the reasoning of the Office Action does not accord that the missing subject matter in Kondo may be established by probabilities or possibilities. Additionally, claim 1 recites that the multimedia information stored by the plurality of multimedia documents is analyzed in response to the input to identify portions of multimedia information that satisfy the selection criterion. The identified portions of multimedia information recited in claim 1 include at least a first portion extracted from a first multimedia document from the plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents. In contrast, Kondo merely discloses that view objects in sequential periods can be combined into one view object. (Kondo: Col. 16, lines 20-28; emphasis added). The Office Action interprets this to "suggest" that portions of multimedia data can be retrieved from more than one file. However, Applicants fail to see how combining multiple view objects into one appraises one ordinarily skilled in the art that the multimedia information stored by the plurality of multimedia documents is analyzed as recited in claim 1 in response to the input to identify portions of multimedia information that satisfy the selection criterion where the identified portions of multimedia information include at least a first portion extracted from a first multimedia document from the

plurality of multimedia documents and a second portion extracted from a second multimedia document from the plurality of multimedia documents.

Applicants further submit that Kanevsky fails to cure the deficiencies discussed above of Kondo. Thus, the Office Action has failed to establish where the combination of references teach or disclose all of the claimed limitations of claim 1, and that one having ordinary skill in that art at the time of the invention would have been motivated to incorporate the teachings of Kondo with the teachings of Kanevsky. Thus, Applicants submit that claim 1 is allowable over the cited references.

Claims 2-28

In light of the deficiencies of Kondo and Kanevsky discussed above, Applicants respectfully traverse the rejections to claims 2-3, 8-9, 12, 14-15, 20-21, 24, and 28 and request reconsideration and withdrawal of the rejections under 35 U.S.C. § 103(a) based on Kondo, in view of Kanevsky, and in further view of Orr. Orr simply fails to cure the deficiencies of Kondo and Kanevsky.

Thus, Applicants respectfully submit that independent claims 6, 11, 13, 18, 23, and 26 are allowable for at least a similar rationale as discussed above for the allowability of claim 1, and others. Applicants submit that dependent claims 2-5, 7-10, 12, 14-17, 19-22, 24-25, and 27-28 that depend directly and/or indirectly from the independent claims 1, 6, 11, 13, 18, 23, and 26 respectively, are also allowable for at least a similar rationale as discussed above for the allowability of the independent claims. Applicants further submit that the dependent claims recite additional features that make the dependent claims allowable for additional reasons.

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CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

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